



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

17

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,014	04/01/2004	Raymond B. Ryan	Ryan -P1-04	9572
28710	7590	07/17/2007		
PETER K. TRZYNA, ESQ. P O BOX 7131 CHICAGO, IL 60680			EXAMINER MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
			3694	
			MAIL DATE	DELIVERY MODE
			07/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,014

Applicant(s)

RYAN, RAYMOND B.

Examiner

Shahid R. Merchant

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on June 12, 2007. Claims 1-51 are pending. Claims 14, 20, 21-24 and 36-45 are amended. Claims 46-51 are added.

Response to Arguments

2. Applicant's arguments, see page 15, section IV, Part A filed June 12, 2007, with respect to claims 14, 21 (22), 22 and 23 have been fully considered and are persuasive. The objection of claims 14, 21 (22), 22 and 23 has been withdrawn.

3. Applicant's arguments, see page 15, section IV, Part B filed June 12, 2007, with respect to claims 20, 21, 42 and 44 have been fully considered and are persuasive. The rejection under 35 U.S.C. 112 2nd paragraph of claims 20, 21, 42 and 44 has been withdrawn.

4. Applicant's arguments, see page 15, section IV, Part C filed June 12, 2007, with respect to claims 9-13, 23, 32-35 and 45 have been fully considered but they are not persuasive. Rules, regulations and laws can change over time. Therefore, it is in appropriate to have the scope of a claim change with time. Since the governments or agencies implementing the rules, regulations and laws meet regularly and have the authority to modify standards, any connection a claim may have to these rules, regulations and laws may have varying scope over time. If the rules, regulations and laws change, the disclosure may no longer support the limitation.

5. Applicant's arguments, see pages 15 and 16, section IV, Part D filed June 12, 2007, with respect to claims 36-45 have been fully considered and are persuasive. The rejection under 35 U.S.C. 101 of claims 36-45 has been withdrawn.

6. Applicant's arguments, see page 16, section IV, Part E filed June 12, 2007, with respect to claims 1-45 have been fully considered but they are not persuasive.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, T. Rowe Price teaches the concept of taking margin loans out against a stock portfolio. A margin is a secured loan with stocks, bonds, and other securities serving as collateral (see Ref. U, page 1). The Ford reference shows a specific ESOP loan balance. T. Rowe Price compares the balance of a loan (in view of Ford ESOP) to the valuation of the account equity (collateral) for compliance with a maintenance level (loan requirement) otherwise there is a margin call. Further, applicant does not make any reference to Regulation T or Regulation U in claim language.

DETAILED ACTION

Priority

8. Examiner has given consideration to applicant's Provisional Application No. 60/459,718 filed on April 1, 2003. For examining purposes of this application, the effective filing date will be April 1, 2003.

Specification

9. The amendment filed June 12, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: page 9, line 18 (book to tax accounting...), page 10, line 4 (tax benefit that arises...) and page 11, line 4 (offset some or all...).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 9-13, 23, 32-35 and 45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. ERISA is a federal law that has

Art Unit: 3694

changed several times since being introduced in 1974. Therefore, ERISA is indefinite because it can change over time.

12. Claims 46-51 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Rules, regulations and laws can change over time. Therefore, it is inappropriate to have the scope of a claim change with time. Since the governments or agencies implementing the rules, regulations and laws meet regularly and have the authority to modify standards, any connection a claim may have to these rules, regulations and laws may have varying scope over time. If the rules, regulations and laws change, the disclosure may no longer support the limitation.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-45 rejected under 35 U.S.C. 103(a) as being unpatentable over T.

Rowe Price (see attached PTO-892, Ref U) in view of Ford (see attached PTO-892, Ref V).

Art Unit: 3694

15. As per claim 1, T. Rowe Price teaches computer-implemented method for monitoring sufficiency of collateral for a loan, the method comprising the steps of:

receiving a valuation of collateral for a loan, the loan at least partially funding acquisition of the collateral held, the collateral including at least one security;

determining a balance of the loan; and

comparing the balance of the loan to the valuation of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement permitted (see pages 3-4). T. Rowe Price does not explicitly teach linking a loan to a benefit plan.

Ford teaches the relationship of loans and benefit plans (see pages 47 and 49—Employee Stock Ownership Plan (ESOP) loan).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to acquire a loan using a participant's benefit plan as collateral because it would allow a participant to "sell short" a security and realize a profit as taught by T. Rowe Price (see page 5).

16. As per claim 2, T. Rowe Price and Ford teach the method of claim 1 as described above. T. Rowe Price further teaches including: signaling an incidence of noncompliance with the loan requirement (see pages 2-4).

Art Unit: 3694

17. As per claim 3, T. Rowe Price teaches the method of claim 2 as described above. T. Rowe Price further teaches including the step of: computing an amount of the collateral to be sold to retire debt to comply with a loan requirement (see pages 4-5).

18. As per claim 4, T. Rowe Price teaches the method of claim 2 as described above. T. Rowe Price further teaches including the step of: computing an amount of additional collateral required to comply with the loan requirement (see pages 4-5).

19. As per claim 5, T. Rowe Price and Ford teach the method of claim 1 as described above. T. Rowe Price further teaches wherein the step of comparing includes:

computing the actual ratio of the loan amount divided by the value of the collateral;

comparing an actual ratio to a test ratio; and

signaling when the actual ratio equals or exceeds the test ratio (see pages 4-6).

20. As per claim 6, T. Rowe Price and Ford teach the method of any one of claims 1-5 as described above. T. Rowe Price further teaches wherein the step of receiving a valuation of collateral carried out with said at least one security including at least one equity security, a put contract for a equity security, or a call contract for an equity security (see pages 1-3).

Art Unit: 3694

21. As per claim 7, T. Rowe Price teaches the method of claim 6 as described above. T. Rowe Price further teaches wherein the step of receiving a valuation of collateral is carried out with said at least one security including at least one of said equity security or said put contract for the equity security (see pages 1-3).

22. As per claim 8, T. Rowe Price teaches the method of claim 7 as described above. T. Rowe Price further teaches wherein the step of receiving a valuation of collateral is carried out with said at least one security including at least one said equity security (see pages 1-3).

23. As per claim 9, T. Rowe Price and Ford teach any one of claims 1-5. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

Art Unit: 3694

24. As per claim 10, T. Rowe Price teaches the method of claim 6. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

25. As per claim 11, T. Rowe Price teaches the method of claim 7. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

26. As per claim 12, T. Rowe Price teaches the method of claim 8. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

27. As per claim 13, T. Rowe Price and Ford teach the method of any one of claims 1-5. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

28. As per claim 14, T. Rowe Price teaches a computer-implemented method for illustrating a financial performance, the method including the steps of:

receiving data, the data including a valuation of collateral for a loan, the loan at least partially funding acquisition of the collateral, the collateral including at least one security, the loan having a balance sufficient for compliance with a loan requirement (see pages 3-4). T. Rowe Price does not explicitly teach linking a loan to a benefit plan and the generating of financial performance over time.

Ford teaches the relationship of loans and benefit plans (see pages 47 and 49) and generating an illustration of benefit plan financial performance over time (see pages 65-66).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to show benefit plan data and an illustration of benefit plan financial performance over time because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 65-66).

29. As per claim 15, T. Rowe Price and Ford teach the method of claim 14 as described above. T. Rowe Price does not explicitly teach the following sub-steps: computing a simple accounting rate for return said participant's benefit plan; computing the plan's internal rate of return; computing the plan's present value gain or loss;

Art Unit: 3694

computing the plan sponsor's GAAP cost; and computing the plan sponsor's present value cost.

Ford teaches computing a simple accounting rate for return said participant's benefit plan; computing the plan's internal rate of return; computing the plan's present value gain or loss; computing the plan sponsor's GAAP cost; and computing the plan sponsor's present value cost (see pages 65-66).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to illustrate a simple accounting rate for return said participant's benefit plan; the plan's internal rate of return; the plan's present value gain or loss; the plan sponsor's GAAP cost; and the plan sponsor's present value cost because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 65-66).

30. As for claims 16-19, the argument used for claim 15 as set forth above applies to claims 16-19 respectively.

31. As per claim 20, T. Rowe Price and Ford teach the method of claim 19 as described above. T. Rowe Price does not explicitly teach the step of: transferring at least one financial performance data to at least one party with an interest in the benefit plan.

Ford teaches the step of: transferring at least one financial performance data to at least one party with an interest in the benefit plan (see pages 46-72).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to transferring at least one financial performance data to at least one party with an interest in the benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

32. As per claim 21, Ford teaches a computer-implemented method of illustrating a comparison of at least one participant in a stock option plan to at least one participant in a participant's benefit plan, the method including the steps of:

receiving financial performance data for a participant's benefit plan,;

receiving the financial performance data for a stock option plan; generating a comparison of the stock option plan and the benefit plan data; and

computing at least one difference between said stock option plan and said benefit plan (see pages 60-61 and 65-66).

Ford does not teach the benefit plan having collateral for a loan to the benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security of a plan benefit sponsor.

T. Rowe Price teaches the benefit plan having collateral for a loan to the benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security of a plan benefit sponsor (see pages 3-4)

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to show differences between a stock option plan and a benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

33. As per claim 22, T. Rowe Price and Ford teach the method of claim 20 as described above. T. Rowe Price does not explicitly teach the step of: transferring financial performance data to at least one party with an interest in the benefit plan.

Ford teaches the step of: transferring at least one financial performance item to at least one party with an interest in the benefit plan (see 46-72).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to transferring at least one financial performance item to at least one party with an interest in the benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

34. As per claim 23, Ford and T. Rowe Price teach the method of claim 21. Ford further teaches wherein at least one of the steps is carried out with the benefit plan being an ERISA benefit plan.

35. As per claim 24, it is in parallel with claim 1 and is rejected for at least the same reason as set forth above.

36. As per claim 25, it is in parallel with claim 2 and is rejected for at least the same reason as set forth above.

37. As per claim 26, it is in parallel with claim 3 and is rejected for at least the same reason as set forth above.

38. As per claim 27, it is in parallel with claim 4 and is rejected for at least the same reason as set forth above.

39. As per claim 28, it is in parallel with claim 5 and is rejected for at least the same reason as set forth above.

40. As per claim 29, it is in parallel with claim 6 and is rejected for at least the same reason as set forth above.

41. As per claim 30, it is in parallel with claim 7 and is rejected for at least the same reason as set forth above.

42. As per claim 31, it is in parallel with claim 8 and is rejected for at least the same reason as set forth above.

43. As per claim 32, it is in parallel with claim 9 and is rejected for at least the same reason as set forth above.

44. As per claim 33, it is in parallel with claim 10 and is rejected for at least the same reason as set forth above.

45. As per claim 34, it is in parallel with claim 11 and is rejected for at least the same reason as set forth above.

46. As per claim 35, it is in parallel with claim 12 and is rejected for at least the same reason as set forth above.

Art Unit: 3694

47. As per claim 36, it is in parallel with claim 14 and is rejected for at least the same reason as set forth above.

48. As per claim 37, it is in parallel with claim 15 and is rejected for at least the same reason as set forth above.

49. As per claim 38, it is in parallel with claim 16 and is rejected for at least the same reason as set forth above.

50. As per claim 39, it is in parallel with claim 17 and is rejected for at least the same reason as set forth above.

51. As per claim 40, it is in parallel with claim 18 and is rejected for at least the same reason as set forth above.

52. As per claim 41, it is in parallel with claim 19 and is rejected for at least the same reason as set forth above.

53. As per claim 42, it is in parallel with claim 20 and is rejected for at least the same reason as set forth above.

54. As per claim 43, it is in parallel with claim 14 and is rejected for at least the same reason as set forth above.

55. As per claim 44, it is in parallel with claim 20 and is rejected for at least the same reason as set forth above.

56. As per claim 45, it is in parallel with claim 23 and is rejected for at least the same reason as set forth above.

Conclusion

57. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid R. Merchant whose telephone number is 571-270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3694

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM


ELLA COLBERT
PRIMARY EXAMINER